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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/327,167	06/07/1999	NAOKI ENOMOTO	684.2848	5127

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

GRAINGER, QUANA MASHELL

ART UNIT PAPER NUMBER

2852

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/327,167

Applicant(s)

ENOMOTO ET AL.

Examiner

Quana Grainger

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 16-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 5/1, 6/5/1, 7/5/1, 8/7/5/1, 9/7/5/1, 10/5/1, 11/10/5/1, 12/11/10/5/1, 12/11/10/5/1, 14/11/10/5/1, 18-26, 33/29, 34/33/29, 35/33/29, 36- 40, 43-46, 50/46, 51/50/46, 52/50/46, 53/52/50/46, 54/52/50/46, 55/50/46, 56/55/50/46, 57/56/55/50/46, 59-60, 63-74, 78/74, 79/78/74, 80/78/74, and 81-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara et al. The image forming apparatus by Fujiwara et al. comprising image bearing means for bearing a toner image; an intermediary transfer member, wherein the toner image is electrostatically transferred from said image bearing means onto said intermediary transfer member, and then transferred from said intermediary transfer member onto a transfer material; wherein said intermediary transfer member includes a first layer, a second layer on said first layer and a third layer on said second layer, for receiving the toner image from said image bearing means (Figure 3), and wherein a volume resistivity of said first layer is smaller than that of said third layer (column 5, lines 22-29), and a volume resistivity of said third layer is smaller than that of said second layer (column 5, line 60 – column 6, line 14; lines 40-56). The apparatus further has transfer means 8 for electrostatically transferring the toner image from said image bearing means onto said intermediary transfer member, wherein said

transfer means applied a voltage to such a side of said intermediary transfer member as is opposite from a side thereof for receiving the toner image. The intermediary transfer member is in the form of a belt (Figure 3). The voltage has a polarity opposite from a regular charging polarity of the toner to cause the transfer of the toner from the image bearing member to the intermediate transfer member. The transfer means 8 is provided with a voltage source for supplying the voltage. The image bearing means is provided with an image bearing member capable of bearing different color toner images. The transfer means for applying a voltage to said first layer to electrostatically transfer the toner image to said intermediary transfer member from said image bearing member. The first layer is coated with said second layer. The second layer is coated with said third layer. The first layer is coated with said second layer, and said second layer is coated with said third layer.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

Art Unit: 2852

made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 2-4, 5/2/1, 5/3/1, 5/4/1, 6/5/2/1, 6/5/3/1, 6/5/4/1, 7/5/2/1, 7/5/3/1, 7/5/4/1, 8/7/52/1, 8/7/53/1, 8/7/54/1, 9/7/52/1, 9/7/53/1, 9/7/54/1, 10/5/2/1, 10/5/3/1, 10/5/4/1, 11/10/5/2/1, 11/10/5/3/1, 11/10/5/4/1, 12/11/10/5/2/1, 12/11/10/5/3/1, 12/11/10/5/4/1, 13/12/11/10/5/2/1, 13/12/11/10/5/3/1, 13/12/11/10/5/4/1, 14/11/10/5/2/1, 14/11/10/5/3/1, 14/11/10/5/4/1, 21/20/19/18/1, 25/24/23/1, 30-32, 33/30/29, 33/31/29, 33/32/29, 34/33/30/29, 34/33/31/29, 34/33/32/29, 35/33/31/29, 35/33/31/29, 35/33/32/29, 47-49, 50/47/46, 50/48/46, 50/49/46, 51/50/47/46, 52/50/47/46, 53/52/50/47/46, 54/52/50/47/46, 55/50/47/46, 56/55/50/47/46, 57/56/50/47/46, 58/57/56/55/50/47/46, 51/50/48/46, 52/50/48/46, 53/52/50/48/46, 54/52/50/48/46, 55/50/48/46, 56/55/50/48/46, 57/56/50/48/46, 58/57/56/55/50/48/46, 51/50/49/46, 52/50/49/46, 53/52/50/49/46, 54/52/50/49/46, 55/50/49/46, 56/55/50/49/46, 57/56/50/49/46, 58/57/56/55/50/49/46 66, 75-77, 78/75/74, 79/78/75/74, 80/79/78/75/74, 78/76/74, 79/78/76/74, 80/79/78/76/74, 78/77/74, 79/78/77/74, 80/79/78/77/74, and 83-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al. in view of Takekoshi et al. Fujiwara et al. does not teach an apparatus wherein the volume resistivity of said third layer is  $10^9$  to  $10^{14}$  Ohm.cm; the apparatus further has supporting means for supporting said intermediary transfer member and the supporting means is provided with a plurality of

rollers; the first layer is elastic; the first layer is a rubber layer; nor the volume resistivity of said second layer is  $10^9$  to  $10^{15}$  Ohm.cm.

Takekoshi et al. teaches an apparatus wherein the image bearing means is provided with a plurality of image bearing members. Takekoshi et al. teaches an image forming apparatus having either a plurality of image bearing members or a single image bearing member and a transfer means.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Takekoshi et al. with the image forming apparatus of Fujiwara et al. since the examiner takes official notice of the equivalence of a color image forming apparatus having a single image bearing member and a plurality of image bearing members and the selection of any of these known equivalents to provide a color image forming apparatus would be within ordinary skill in the art.

The base layer is not recited as being an elastic or rubber layer; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the appropriate material for the base layer since it has been held that selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### **Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quana Grainger whose telephone number is 703-308-7616. The examiner can normally be reached on weekdays between the hours of 9-6.

Art Unit: 2852

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on 703-308-1373. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-3431.

A handwritten signature in black ink, appearing to read 'Quana Grainger', with a long horizontal flourish extending to the right.

Quana Grainger  
Primary Examiner  
Art Unit 2852

QG  
September 23, 2002